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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,280	03/12/2004	Thomas S. Neal	200314060-1	1301

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EXAMINER	
WRIGHT, INGRID D	

ART UNIT	PAPER NUMBER
2835	

NOTIFICATION DATE	DELIVERY MODE
12/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/800,280	NEAL ET AL.	
	Examiner	Art Unit	
	Ingrid Wright	2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 16-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *22 and 23* is/are allowed.

6)☒ Claim(s) *1-3,5-14 and 16-21* is/are rejected.

7)☒ Claim(s) *4* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,11,14 & 21 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Re claims 1,11,14 & 21, the limitations: "and in which the body remains without one exerting pressure on the body," is not included in the specification.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 & 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Kaminski US 5400902.

Note: Figs. 2,3 & 5 of Kaminski, presented in the Office Action, dated 4/24/06, still holds and represents claimed limitations, in the instant application.

Claim 1, as best understood, Kaminski teaches a post (36), for retaining an item (31) in a storage compartment (20), having a side (e.g. sides of compartment (20) is not labeled, but shown in fig. 1 of

Kaminski), the post (36) comprising: a body (e.g., body of (36)) operable to hold the item (31); and a coupling element (34) operable to couple the body to the side of the storage compartment (20) and to allow the post (36) to be moved to a position (e.g. position #1 is shown by solid lines of (36), in fig. 5 of Kaminski) in which the body can receive an item (31) to be stored in the compartment, and to a different position (e.g. position #2 is shown by dashed lines of (36), in fig. 5 of Kaminski), in which a bottom surface of a finger (54) of the body can not receive (i.e., receive as defined by Webster: to support the weight or pressure of) an item (31) to be stored in the compartment (20), in the second position.

Citation only: Official Notice is taken in regards to a body being moved to a second position in which, the body can not receive an item to be stored in compartment, as Pettigrew et al. US teaches a body, moved to a second position (e.g. position of (body (10) as shown in fig. 3B of Pettigrew et al.), in which portions (11) the body (10) can not receive (i.e. body (10) can not support the weight or pressure of) an item (12), to be stored in a base (1) of a compartment.

Claim 2, Kaminski, teaches wherein the body (e.g., body of (36)) is releasably fastened (via a button (32)) to the side of the storage compartment (20).

Claim 3, Kaminski teaches a body (e.g., body of (36)), pivotable relative to the side (e.g. sides of compartment is not labeled, but shown in fig. 1 of Kaminski) of the storage compartment (20).

Claim 6, Kaminski teaches the coupling element (34), which includes a protrusion (62) insertable into a hole (e.g. area of lower cover insert receptacle (28)).

Claim 7, Kaminski teaches the coupling element (34) includes a protrusion (62) extending from the body (e.g., body of (36)), and a hole (e.g. area of lower cover insert receptacle (28)) in the side of the storage compartment (20) operable to receive the protrusion (62).

Claim 8, Kaminski teaches wherein the item (31) to be stored in the storage compartment (20) includes a disc (31) having a hole (76), and the body (e.g., body of (36)) is insertable into the hole (76).

Claim 9, Kaminski teaches wherein the item (31) to be stored in the storage compartment (20) includes a storage disc (31) having a hole, and the body (e.g., body of (36)) is insertable into the hole and includes a shoulder (50) to support the storage disc (31) away from the side (e.g. side of compartment (20)).

Claim 10, Kaminski teaches the body (e.g., body of (36)) which includes a first component (e.g., two bodies (36), as shown on fig. 5 of Kaminski) and a second component (e.g., two bodies (36) as shown on fig. 5 of Kaminski), and the coupling element (34) includes: a first element operable (34) to couple the first component to the side of the storage compartment (20) and to allow the first component to be positioned relative to the side (e.g. sides of compartment is not labeled, but shown in fig. 1 of Kaminski) in at least two different positions (e.g. positions shown in fig. 5 of Kaminski), and a second element operable (34) to couple the second component to the side (e.g. sides of compartment is not labeled, but shown in fig. 1 of Kaminski) of the storage (20) and to allow the second component to be positioned relative to the side in at least two different positions.

Claim 11, as best understood, Kaminski teaches a storage compartment (20) comprising a bottom and a sidewall (e.g. sidewalls are unlabeled, but shown in fig. 5 of Kaminski) that define an interior, and a post (36) operable to retain a storage disc (31), and including a body (e.g. body of (36)) operable to engage the storage disc and a coupling element (34) operable to couple the body to the bottom of the storage compartment (20) and to allow the body to be positioned relative to the bottom in at least two different positions that include a position (e.g. position#1 shown by solid lines of the body of (36)) of the body in which the body can receive the storage disc (31) when the disc is stored in the compartment, and a position (e.g. position#2 shown by dashed lines of the body of (36)) in fig. 5 of Kaminski) in which the body can not receive the storage disc (31) when the disc is stored in the compartment (20).

Claim 12, Kaminski teaches wherein in one position (e.g. position of body (36) in fig. 5 of Kaminski) the body extends from the bottom into the interior substantially perpendicular to the bottom (e.g. extended perpendicular position shown by body of (36) in fig. 5 of Kaminski).

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smeege, Jr. et al. US 6535379 B1 (hereinafter: "Smeege") in view of Kaminski US 5400902.

Claim 21, as best understood, Smeege, Jr. et al. teaches a computer system (10) comprising a housing (20) having a storage compartment (col. 3, lines 30-35 of Smeege et al.) to retain an item (CD,DVD) and including: a bottom (bottom surface shown in fig. 2 of Smeege et al.) and a sidewall (side surface shown in fig. 2 of Smeege et al.) that define an interior (shown by recess of fig. 2 of Smeege et al.), and a post (44) operable to retain a storage disc (col. 3, lines 30-35 of Smeege et al.), and having: a body (see, body of (44)) operable to engage the storage disc and a processor (inherent) disposed in the housing (20), but is silent as to a coupling element operable to couple the body (e.g. body of (44)) to an interior of the storage compartment and a position in which the body can not receive the storage when the disc is stored in the compartment (20). Kaminiski teaches a system for retaining an item (31), which allows a body (see, body of components (36)) to be pivoted (see, two different positions of fig. 5 of Kaminski) and a coupling element (34) operable to couple the body (see, body of components (36)) of a storage compartment (20) and a position (e.g. position#2 as shown by dashed lines of the body of (36) in fig. 5 of Kaminski) in which the body (e.g. body of (36)) can not receive the storage disc when the disc (31) is stored in the compartment (20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the body and coupling element as taught by Kaminski in the invention of Smeege et al., in order to provide a control and enhanced grip system for the disc to engage the post (44) of Smeege, Jr. et al.

4. Claims 5,13,14 & 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminski US 5400902 in view of Marsilio et al. US 6799677 B2 (hereinafter: "Marsilio").

Claim 5, in regards to all the limitations of claim 1 above, Kaminski teaches wherein the position (e.g. position #1 of the body of (36) as shown in fig. 5 of Kaminski) in which the body (e.g. body of (36)

receives an item (31) stored in the compartment (20) includes the body substantially perpendicular to the side, and a position (e.g. position#2 as shown by dashed lines of the body of (36) in fig. 5 of Kaminski) in which the body does not receive an item (31) stored in the compartment (20) is somewhat parallel with the side, but is silent as to the body being substantially parallel with the side, in the position in which the body does not receive an item (12). Marsilio teaches lowering a body of post (32) (col. 5, lines 44-50, Marsilio), substantially near a side of a storage compartment (200), in order to provide additional storage space and prevent interference with a disc holding page (206) containing additional hubs, but is silent as to a position of the post being substantially parallel with the side of the compartment (200). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a configuration, in which the body of the post (36) are substantially parallel with the side, in order to provide additional space within the compartment (20) of Kaminski, to receive a disk page, commonly found in many disk containers or cases.

Claim 13, in regards to all the limitations of claim 11 above, Kaminsk is silent as to one position of the body being disposed in a receptacle of the bottom, below a surface of the bottom. Marsilio teaches a post (100), and a position in which a body (e.g. body of (100)) is disposed in a receptacle of a bottom (e.g. (post (100) are shown in a recess of a bottom surface, in fig. 8, Marsilio), below a surface of the bottom, in order to prevent an item such as a disk from flexing while the disk is being removed (col. 1, lines , Marsilio). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the configuration of Marsilio, over the configuration of Kaminski, in order to provide an enhanced means of preventing a user from flexing and damaging the item (31) when removing the item from the storage compartment (20) of Kaminski. Further, one would be motivated to combine the art of Kaminski with Marsilio et al., since each invention utilizes push button retainers or hubs, for removing a disc.

Regarding the method claims 14 & 16-20, the method steps recited in the claims are inherently necessitated by the device structure as taught by Kaminski & Marsilio. Kaminski & Marsilio, as best understood, disclosed a method for storing a storage disc, the method comprising a body (body of (36)) of a post (36) positioned relative to a side of a storage compartment (20), from a position in which the body can not receive the storage disc (31) when the disc is stored in the compartment (20), to a different position (e.g. position#1 as shown by solid lines of the body of (36) in fig. 5 of Kaminski) in which the body can receive the storage disc (31) when the disc is stored in the compartment, and engaging a hole (76) in the disc (31) with the body, wherein the body is retained in the position, wherein the disc (31) is supported away from the side, wherein the hole (76) is disengaged in the disc from the body, the body is positioned relative to the side, to the position (e.g. position#2 shown by dashed lines of the body of (36)) in which the body can not receive the disc (31) when the disc is stored in the compartment and another item is placed in the storage compartment (20), wherein the body is positioned relative to the side includes the post (36) pivoted relative to the side, wherein the body (e.g. body of (100)) is positioned relative to the side, includes the body (e.g. body of (100)) disposed below a surface (e.g. post (100) is shown in a recess below a surface of a bottom, fig. 8, Marsilio) of the side in a receptacle (200).

Allowable Subject Matter

5. Claims 22 & 23 are allowed.

6. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: the allowability resides in the overall structure of the device as recited by claims 4,22 & 23, and at least in part, because claim 4 & 22 recite: "the coupling element including a locking element," and claim 23 recites: "wherein in one position the body is disposed in a receptacle of the bottom, below a surface of the bottom." The

aforementioned limitations in combination with all remaining limitations of claims 4,22 & 23, are believed to render the claims 4,22 & 23 and all claims dependent thereupon, patentable over the art of record.

Response to Arguments

8. Applicant's arguments, filed 10/26/07, have been fully considered.

Re Applicant's arguments, of claim 1, 11,14,21 and the dependent claims thereupon, wherein the post (36) is not moved to a different position in which the body can not receive an item to be stored in the compartment, and in which the body remains without one exerting pressure on the body, the Examiner respectfully disagrees and notes that Kaminski teaches a first position (e.g. position #1 is shown by solid lines of (36), in fig. 5 of Kaminski) and a second position (e.g. position #1 is shown by dashed lines of (36), in fig. 5, Kaminski), different from the first position, in which body (e.g. body of (36)) can not receive an item to be stored in the compartment. In this position, the body (e.g. body of (36)) can not receive (i.e., receive as defined by Webster: to support the weight or pressure of) the disk or item (31). The limitations, "and in which the body remains without one exerting pressure on the body," is not included in the specification.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ingrid Wright whose telephone number is (571)272-8392. The examiner can normally be reached on M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jayprakash Gandhi can be reached on (571)272-2800, ext 35. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IDW

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12/6/07

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